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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,893	07/11/2003	Phillip J. Bouic	56852US004	4044

32692 7590 06/18/2007

3M INNOVATIVE PROPERTIES COMPANY
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EXAMINER	
MIGGINS, MICHAEL C	

ART UNIT	PAPER NUMBER
1772	

NOTIFICATION DATE	DELIVERY MODE
06/18/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary	Application No.	Applicant(s)	
	10/617,893	BOUIC, PHILLIP J.	
	Examiner	Art Unit	
	Michael C. Miggins	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,9,11-47 and 49-60* is/are pending in the application.

4a) Of the above claim(s) *49-60* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9 and 11-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/06 has been entered.

REJECTIONS WITHDRAWN

2. All of the 102(e) and 103(a) rejections maintained in the final rejection of 2/9/06, page 2, line 4 have been withdrawn.

REJECTIONS REPEATED

3. There are no rejections repeated.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 7-9, 16-22, 29-30, 32-33, 36, 38, 42-44 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Voss (US 2002/0022158 A1).

Voss discloses an article for use as a masking material to mask a gap between two relatively movable parts (page 1, paragraph [0010] and Fig. 76A) comprising an elongate strip having at least first and second separate edge forming portions for contacting each of the two parts (see Figs. below and Fig. 76A), a flexible web portion connecting each of the two parts, a flexible web portion connecting the first and second edge forming portions for hinging movement such that the first and second edge forming portions can move independently of each other, and adhesive (see Figs. below and Fig. 76A as well as page 11, paragraphs [0250] – [0252]) one side of the connecting web portion for attaching the elongate strip to one of the parts such that said one part is contacted by an adhesive free surface of the first edge forming portion and the other part is contacted by the second edge forming portion (see Figs. below and Fig. 76A) (applies to instant claims 1-2 and 48).

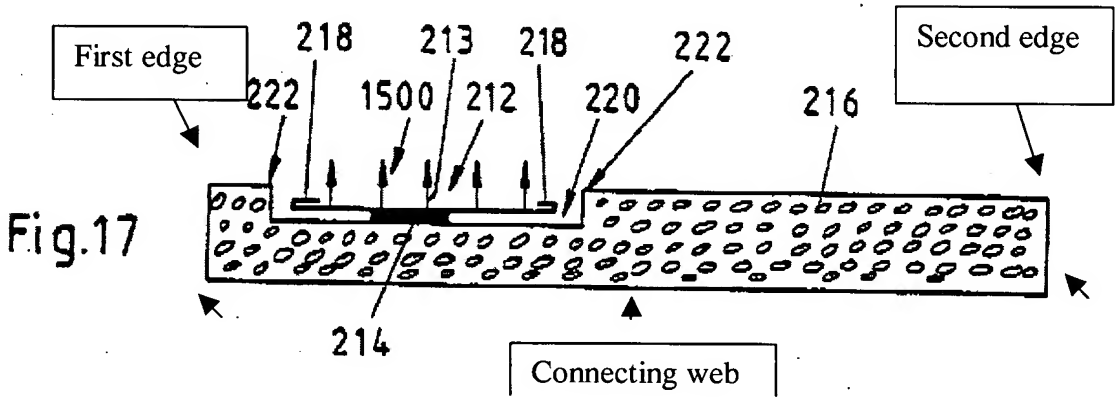
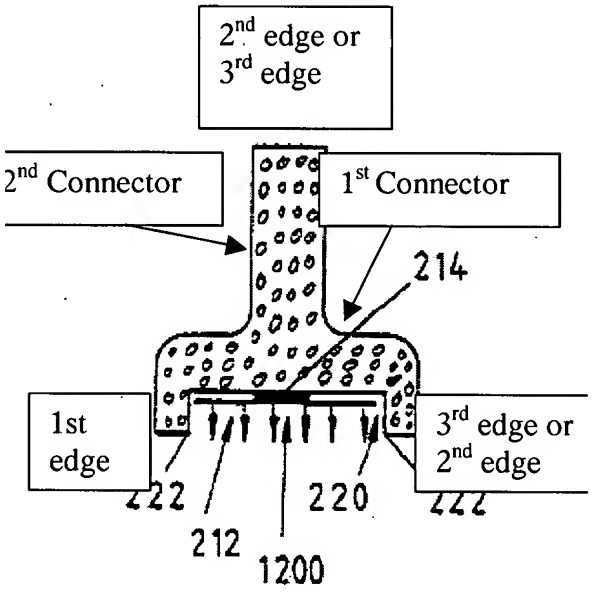


Fig.17



Voss also discloses wherein the article is made of foam (page 1 paragraph [0010]), wherein the connecting web is of reduced thickness relative to at least one, or both, of the first and second edges (see Figs above), wherein the connecting web portion and the other edge are of the same thickness (see Fig. 3A), wherein the second edge forming portions is connected to a third edge forming portion by a second connecting web portion, wherein the second edge forming portion has a larger transverse cross-section than each of the first and third edge forming portions (see Figs above), wherein each of the first and third edge forming portions have the same or different transverse cross-sections (see second Fig above), wherein the connecting web portion has a width transverse to the length of the strip and is of uniform thickness (see second figure above), wherein the connecting web varies in thickness (see first figure above), wherein the web connecting is smooth (see second figure above) (applies to instant claims 3, 7-9, 16-22).

Voss also discloses wherein the adhesive (214, second figure above) is applied to the connecting web portion as a stripe extending lengthwise of the elongate strip, wherein the sripe is continuous (214, second figure above), wherein the connecting web portion has a width transverse to the length of the strip and the adhesive extends across the full width of the connecting web (644 from 76A and page 11, paragraphs [0250] – [0252]), wherein the adhesive extends partially across the width of the connecting web (see second figure above), wherein the adhesive free surface of said one edge forming portion is provided by an adhesive free region extending lengthwise of the elongate strip (see both figures above), wherein the article comprises a polymer material (since plastic is disclosed (page 1, paragraph [0007]) (applies to instant claims 29-30, 32-33, 36 and 38).

Claims 42-44 in their entirety recite method limitations which do not structurally further limit the product claim 1 from which they depend. Therefore, the prior art need not teach the method limitations to read on applicant's claims as written since product claims are defined by structure and not the method from which the product is made (MPEP 2113).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3, 9-27, 21, 29-30, 32-38, 42-47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 2002/0022158 A1) in view of Jevons (US 6627259).

Voss discloses an article for use as a masking material to mask a gap between two relatively movable parts (page 1, paragraph [0010] and Fig. 76A) comprising an elongate strip having at least first and second separate edge forming portions for contacting each of the two parts (see Figs. below and Fig. 76A), a flexible web portion connecting each of the two parts, a flexible web portion connecting the first and second edge forming portions for hinging movement such that the first and second edge forming portions can move independently of each other, and adhesive (see Figs. below and Fig. 76A as well as page 11, paragraphs [0250] – [0252]) one side of the connecting web portion for attaching the elongate strip to one of the parts such that said one part is contacted by an adhesive free surface of the first edge forming portion and the other part is contacted by the second edge forming portion (see Figs. below and Fig. 76A) (applies to instant claims 1-2 and 48).

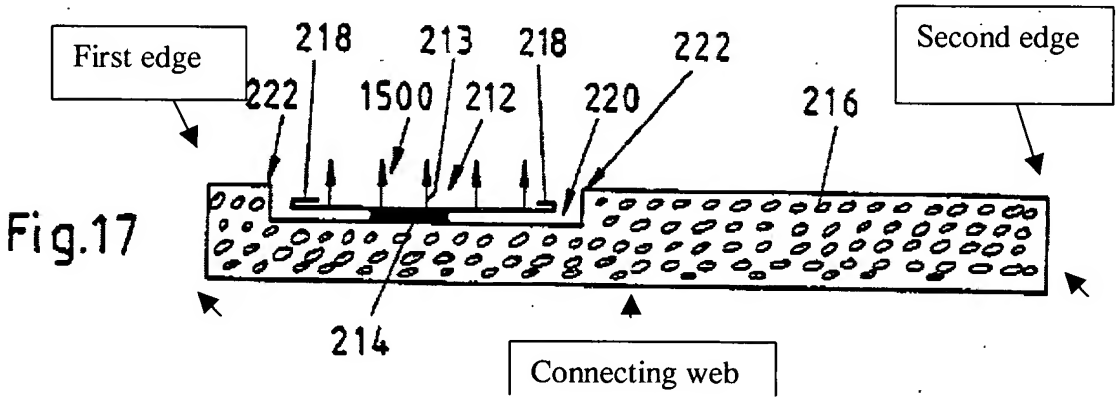
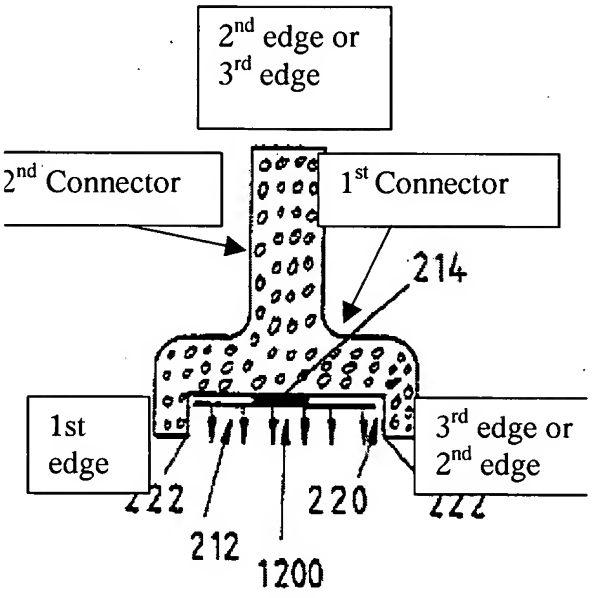


Fig.17



Voss also discloses wherein the article is made of foam (page 1 paragraph [0010]), wherein the connecting web is of reduced thickness relative to at least one, or both, of the first and second edges (see Figs above), wherein the connecting web portion and the other edge are of the same thickness (see Fig. 3A), wherein the second edge forming portions is connected to a third edge forming portion by a second connecting web portion, wherein the second edge forming portion has a larger transverse cross-section than each of the first and third edge forming portions (see Figs above), wherein each of the first and third edge forming portions have the same or different transverse cross-sections (see second Fig above), wherein the connecting web portion has a width transverse to the length of the strip and is of uniform thickness (see second figure above), wherein the connecting web varies in thickness (see first figure above), wherein the web connecting is smooth (see second figure above) (applies to instant claims 3, 7-9, 16-22).

Voss also discloses wherein the adhesive (214, second figure above) is applied to the connecting web portion as a stripe extending lengthwise of the elongate strip, wherein the sripe is continuous (214, second figure above), wherein the connecting web portion has a width transverse to the length of the strip and the adhesive extends across the full width of the connecting web (644 from 76A and page 11, paragraphs [0250] – [0252]), wherein the adhesive extends partially across the width of the connecting web (see second figure above), wherein the adhesive free surface of said one edge forming portion is provided by an adhesive free region extending lengthwise of the elongate strip (see both figures above), wherein the article comprises a polymer material (since plastic is disclosed (page 1, paragraph [0007]) (applies to instant claims 29-30, 32-33, 36 and 38).

Claims 42-44 in their entirety recite method limitations which do not structurally further limit the product claim 1 from which they depend. Therefore, the prior art need not teach the method limitations to read on applicant's claims as written since product claims are defined by structure and not the method from which the product is made (MPEP 2113).

Voss discloses wherein the connecting web portion is located on a major axis of both edge forming portions, wherein the first and second edge forming portions have the same transverse cross-sections, wherein a single stripe of adhesive is applied to the connecting web portion (see both figures above).

The difference between the instant claims and Voss is that Voss fails to disclose wherein first and second edge portions have elliptical transverse cross-section, wherein

the connecting web portion is tangential to both edge forming portions, wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to the other edge forming portion, wherein the first and second edge forming portions have different transverse cross-sections, wherein the connecting web portion has a width transverse to the length of the strip and is of variable thickness across the width, and wherein adhesive is put on at least one of the edge forming portions.

Jevons discloses wherein first and second edge portions have elliptical transverse cross-section (see Fig. 21), wherein the connecting web portion is tangential to both edge forming portions (see Fig. 21), wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to the other edge forming portion (see Fig. 7), wherein the first and second edge forming portions have different transverse cross-sections (see Figs. 5-12 and 16), wherein the connecting web portion has a width transverse to the length of the strip and is of variable thickness across the width (see Figs. 5-6), and wherein adhesive is put on at least one of the edge forming portions (see Figs. 5-12 and 16) in a masking material (column 1, lines 39-47) for the purpose of providing improved masking from paint.

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided wherein first and second edge portions have elliptical transverse cross-section, wherein the connecting web portion is tangential to both edge forming portions, wherein the connecting web portion is located on a major axis of one of the first and second edge forming portions and is tangential to

the other edge forming portion, wherein the first and second edge forming portions have different transverse cross-sections, wherein the connecting web portion has a width transverse to the length of the strip and is of variable thickness across the width, and wherein adhesive is put on at least one of the edge forming portions in the article of Voss in order to provide improved masking from paint as taught or suggested by Jevons.

Claims 23-27 recite various shapes for the connecting webs. However, a change in shape, in the absence of clear and convincing evidence of unexpected results, is obvious and within the level of one of ordinary skill in the art (MPEP 2144). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the recited shapes for the connecting webs in order to provide improved masking from paint.

Claim 37 recites a value for the length of the adhesive free strip. However, finding the workable or optimum value for a result effective variable, absent clear and convincing evidence of an unexpected result, is obvious and within the level of one of ordinary skill in the art (MPEP 2144). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the recited value in order to provide improved masking from paint.

Claims 45-47 recite obvious engineering design choices and it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the recited design choices in order to provide improved masking from paint.

8. Claims 4-6, 28, 31 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 2002/0022158 A1) in view Western (US 5885395).

The difference between Voss and the instant claims is that Voss fails to disclose wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven.

Western discloses wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven (column 2, lines 33-48, column 3, lines 1-12) in a masking material for the purpose of providing improved masking from paint (applies to instant claims 4-6, 28, 31 and 39-41).

Therefore it would have been obvious to have provided wherein the foam material is an open or closed cell polymeric foam, wherein the foam material is a polyurethane or polyolefin foam, wherein the adhesive is a pressure sensitive adhesive, wherein the stripe is discontinuous, wherein the polymer is an elastomer, a thermoplastic, and wherein the polymer is non-woven in the article of Voss in order to provide improved masking from paint as taught or suggested by Western.

ANSWERS TO APPLICANT'S ARGUMENTS

9. Applicant's arguments have been carefully considered but are deemed unpersuasive.

All arguments with regard to the 102(e) rejection previously of record are moot since the rejection has been withdrawn.

Applicant has argued that neither Voss nor Jevons discloses a masking article comprising an elongate strip having first and second edge forming portions having an elliptical transverse cross-section separated by a flexible web portion having a reduced thickness relative to at least one of the edge forming portions. However, Jevons discloses two edges having an elliptical transverse cross-section (see Fig. 21 of Jevons) and Voss discloses a flexible web portion having a reduced thickness relative to at least one of the edge forming portions as described in the rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Miggins
Primary Examiner
Art Unit 1772

MCM
June 11, 2007